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09/964,058	09/26/2001	Daniel Travis Lay	10015670-1	1415

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
DULANEY, BENJAMIN O	
ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/964,058	LAY, DANIEL TRAVIS	
	Examiner	Art Unit	
	Benjamin O. Dulaney	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-12 and 14-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, 4-12 and 14-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/20/06 have been fully considered but they are not persuasive.

Regarding applicant's arguments for claim 10, that Goodman does not teach means for analyzing printing resolution, Examiner continues to disagree. Goodman teaches an enhancement function for enhancing image resolution. A standard well known purpose of enhancing an image is to make it look better, i.e. the image was judged deficient in some manner if it was enhanced. Even if the enhancement function did not contain any "analysis" (which, if broadly interpreted, the function inherently contains analysis), Goodman still teaches in Column 4, lines 40-42 that there is "a compatibility determination module ... which determines whether the printer and content of the document to be printed are compatible or incompatible". Resolution would certainly be encompassed by "content of the document" and therefore has an analysis performed. Applicant appears to further argue that Goodman does not teach determining if resolution is optimized for transparency printing. However, determining if resolution is optimized for transparency printing is not claimed and therefore the argument is moot. Applicant further argues that Goodman does not teach notification when printing resolution is not optimized for transparency printing. This argument is again rendered moot for the reason that the feature is not claimed.

Regarding applicant's arguments for claim 1, that Goodman in view of Torpey does not teach "analyzing font sizes so as to determine whether formatting of a

document is optimized for transparency printing", Examiner disagrees with applicant's characterization of the claim. The claim merely states that a document is to be printed on a transparency (which Goodman teaches Column 5, lines 16-20), and that an analysis is conducted on the font sizes used in the document (which Torpey teaches Column 16, line 61 – Column 17, line 28). "Analyzing font sizes ***so as to determine*** whether formatting of a document is optimized for transparency printing" is not claimed. "Determining whether formatting of the document is optimized for transparency printing" is what is claimed and is taught by Goodman in Column 5, lines 16-33. Goodman clearly teaches transparency printing in Column 5, line 20, and further teaches analyzing a document's "characteristics" (examiner reads format, among other things) to see if it is optimized for a specific printer chosen to print the document onto a medium which could be a transparency.

Applicant's arguments, see pages 10-13, filed 12/20/06, with respect to the rejection(s) of claim(s) 14-23 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. patent 6,226,107 by Tsai and U.S. patent 6,195,181 by Washizu.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1) Claims 10 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,757,071 by Goodman et al.

2) Regarding claim 10, Goodman teaches a method for optimizing transparency printing, comprising the steps of: analyzing a document that is to be printed on a transparency (Column5, lines 16-20); determining whether formatting of the document is optimized for transparency printing (Column 5, lines 15-30); wherein the means for analyzing the document comprises analyzing the printing resolution to be used to print the document (Column 4, lines 1-4; Column 4, lines 40-42); and alerting a user if the document formatting is not optimized for transparency printing (Column 4, lines 45-49).

3) Regarding claim 12, Goodman teaches the step of analyzing the document comprises analyzing colors used to create the document (Column 5, lines 5-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4) Claims 1, 2, 4-9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,757,071 by Goodman et al., and further in view of U.S. Patent 6,753,976 by Torpey et al.

5) Regarding claim 1, Goodman teaches a method for optimizing transparency printing, comprising the steps of: analyzing a document that is to be printed on a transparency (Column5, lines 16-20); determining whether formatting of the document is optimized for transparency printing (Column 5, lines 15-30); and alerting a user if the document formatting is not optimized for transparency printing (Column 4, lines 45-49).

Goodman does not disclose the step of analyzing the document comprising analyzing font sizes used in the document.

Torpey does disclose the step of analyzing the document comprising analyzing font sizes used in the document (column 16, line 61 – column 17, line 28).

Goodman and Torpey are combinable because they are both from the transparency-printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goodman by Torpey to analyze font sizes. The motivation for doing so would have been for "analysis of print quality" (Column 17, line13). Therefore it would have been obvious to combine Goodman with Torpey to obtain the invention as specified in claim 1.

6) Regarding claim 2, Goodman teaches the step of receiving an indication that a document is to be printed on a transparency prior to analyzing the document (Column 4, lines 19-34; Column5, lines 16-20).

7) Regarding claim 4, Goodman teaches the step of analyzing the document comprises analyzing colors used to create the document (Column 5, lines 5-9).

8) Regarding claim 5 Goodman teaches the method of claim 1, wherein the step of analyzing the document comprises analyzing the printing resolution to be used to print the document (Column 4, lines 1-4).

9) Regarding claim 6, Goodman teaches the step of determining whether the document formatting is optimized for transparency printing comprises determining whether the document formatting will result in a clear, high resolution projected image. (Column 4, lines 1-4).

10) Regarding claim 7, Goodman teaches the method of claim 1, wherein the step of alerting a user if the document formatting is not optimized for transparency printing comprises facilitating presentation of a warning dialogue box to the user (Column 4, lines 25-29).

11) Regarding claim 8, Goodman teaches the method of claim 1, further comprising the step of suggesting alternative formatting where the document formatting is not optimized for transparency printing (Column 5, line 48 – Column 6, line 3; Figure 6).

12) Regarding claim 9, Goodman teaches the method of claim 8, further comprising the step of automatically adjusting the document formatting for the user such that the document formatting is optimized for transparency printing (Column 6, lines 4-10; Figure 7).

13) Regarding claim 11, Goodman does not disclose the system of claim 10, wherein the means for analyzing the document comprising analyzing font sizes used in the document.

Torpey does disclose the system of claim 10, wherein the means for analyzing the document comprising analyzing font sizes used in the document (column 16, line 61 – column 17, line 28).

Goodman and Torpey are combinable because they are both from the transparency-printing field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Goodman by Torpey to analyze font sizes. The motivation for doing so would have been for "analysis of print quality" (Column 17, line13). Therefore it would have been obvious to combine Goodman with Torpey to obtain the invention as specified in claim 11.

14) Claims 14, 17, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,111,659 by Murata and further in view of U.S. patent 6,226,107 by Tsai and further in view of U.S. patent 6,195,181 by Washizu.

15) Regarding claims 14 and 21, Murata teaches alerting a user if the scanning resolution is not appropriate for scanning (Column 10, line 57 – Column 11, line 7).

Murata does not teach a method for optimizing transparency scanning; comprising the steps of: analyzing a document to be scanned to determine whether the document is a transparency document; determining whether the scanning resolution is

appropriate for scanning a transparency where the document is determined to be a transparency document.

Washizu teaches analyzing a document to be scanned to determine whether the document is a transparency document (Column 3, lines 49-64).

Murata and Washizu are combinable because they are both from the scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata by Washizu to add determining whether a document is a transparency. The motivation for doing so would have been so that "the position of the illuminating means is changed" (Column 3, line 58).

Tsai teaches determining whether the scanning resolution is appropriate for scanning a transparency where the document is determined to be a transparency document (Column 1, lines 38-47; Column 2, lines 19-28).

Determining which path light will take on its way to lenses of differing resolution when a transparency is involved reads on the claimed feature.

Murata and Tsai are combinable because they are both from the scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata by Tsai to add determining whether a resolution is appropriate for a transparency. The motivation for doing so would have been "because transparent documents usually need higher resolution" (Column 2, lines 25-26).

Therefore it would have been obvious to combine Murata, Tsai and Washizu to obtain the invention specified by claims 14 and 21.

16) Regarding claim 17, Murata teaches the method of claim 14, wherein the step of determining whether the scanning resolution is appropriate comprises determining whether a selected scanning resolution is at least a minimum scanning resolution threshold (Column 10, line 57 – Column 11, line 7).

17) Regarding claim 18, Murata teaches the method of claim 14, wherein the step of alerting a user if the scanning resolution is not appropriate for scanning a transparency comprises facilitating presentation of a warning dialogue box to the user (Column 10, line 57 – Column 11, line 7).

18) Claims 15 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (as modified by Tsai and Washizu) as applied to claims 14 and 21 above, and further in view of U.S. Patent 5,381,526 by Ellson.

Regarding claims 15 and 22, Murata (as modified by Tsai and Washizu) does not teach the step of analyzing the document comprising conducting an initial scan of the document and detecting the reflectivity observed during the initial scan.

Ellson does teach the step of analyzing the document comprising conducting an initial scan of the document and detecting the reflectivity observed during the initial scan (column 4, lines 17-37).

Murata (as modified by Tsai and Washizu) and Ellson are combinable because they are both from the transparency-scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata (as modified by Tsai and Washizu) by Ellson to detect reflectivity. The motivation for doing so would have been to "provide this other information about a scene in digitized form" (Column 4, lines 35-37). Therefore it would have been obvious to combine Murata (as modified by Tsai and Washizu) with Ellson to obtain the invention as specified in claims 15 and 22.

19) Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (as modified by Tsai and Washizu) as applied to claims 14 and 21 above, and further in view of U.S. Patent 5,283,671 by Stewart et al.

Murata (as modified by Tsai and Washizu) does not teach the step of analyzing the document comprises conducting an initial scan of the document and detecting the brightness observed during the initial scan.

Stewart does teach the step of analyzing the document comprises conducting an initial scan of the document and detecting the brightness observed during the initial scan (column 5, lines 1-25).

Murata (as modified by Tsai and Washizu) and Stewart are combinable because they are both from the transparency-scanning field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata (as modified by Tsai and Washizu) by Stewart to detect brightness. The motivation for doing so would have been to evaluate and categorize some characteristics (Column 5, lines 19-20). Therefore it would have been

obvious to combine Murata (as modified by Tsai and Washizu) with Stewart to obtain the invention as specified in claims 16 and 23.

20) Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata (as modified by Tsai and Washizu) as applied to claims 14 and 21 above, and further in view of U.S. 6,757,071 by Goodman et al.

21) Regarding claim 19, Murata (as modified by Tsai and Washizu) teaches scanning (Figure 1, Murata)

Murata (as modified by Tsai and Washizu) does not teach the method of claim 14, further comprising the step of suggesting an alternative scanning resolution where the scanning resolution is not optimized for transparency scanning.

Goodman teaches the method of claim 14, further comprising the step of suggesting an alternative resolution where the resolution is not optimized (Column 5, line 48 – Column 6, line 3; Figure 6).

Sugiyama (as modified by Murata) and Goodman are combinable because they are both from the transparency field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Murata (as modified by Tsai and Washizu) by Goodman to add suggesting alternative resolutions. The motivation for doing so would have been so that "modification options are presented" (Column 5, line 57). Therefore it would have been obvious to combine Murata (as modified by Tsai and Washizu) with Goodman to obtain the invention as specified in claim 19.

22) Regarding claim 20, Murata (as modified by Tsai and Washizu) teaches the method of claim 19, further comprising the step of automatically adjusting the scanning resolution such that it is optimized for transparency scanning (Tsai, Column 2, lines 18-28).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin O. Dulaney whose telephone number is (571) 272-2874. The examiner can normally be reached on Monday - Friday (9am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Dulaney

TWYLER LAMB
SUPERVISORY PATENT EXAMINER